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APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO
09/881,091	06-15 2001	Kiril A. Pandelisev	PHOENIX SCIENTIFIC	7262

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EXAMINER

HOFFMANN, JOHN M

ART UNIT

PAPER NUMBER

1731

DATE MAILED: 05/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/881,091

Applicant(s)

PANDELISEV, KIRIL A.

Examiner

John Hoffmann

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-150 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-150 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s) ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-16 and 26-64, drawn to an apparatus for forming fiber preforms, classified in class 65, subclass 494.
- II. Claims 17-25, 65-102, 104-121, 123-128, 131-150, drawn to a method of making a preform, classified in class 65, subclass 391.
- III. Claims 103, 122, 129, 130, drawn to a product made using the preform-making process, classified in class 428, subclass 428.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus can be used for a materially different process, such as applying a powdered-metal coating to a metal part.

Inventions II and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process

(MPEP § 806.05(f)). In the instant case the product can be made by a materially different process, such as extruding glass product from a melt that is formed from raw materials or from bulk materials.

Inventions I and III are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product or (2) that the product as claimed can be made by another and materially different apparatus (MPEP § 806.05(g)). In this case the apparatus can be used for making a different product such as a metal engine part that was given a coating. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

This application contains claims directed to the following patentably distinct species of the claimed invention:

Specie A1 where there is exactly one substrate

Specie A2 where there are exactly two substrates

Specie A3 where there are three or more substrates

Specie B1 where the invention is for making a core

Specie B2 where the invention is for making cladding

Specie B3 where the invention is for making a core and cladding

Specie C1 where the invention involves sol-gel processing

Specie C2 where the invention involves feeding a powder which is deposited

Specie C3 where the invention involves soot generation/hydrolysis of a compound

Specie D1 where the invention involves deposition with a plasma

Specie D2 where the invention involves deposition with a non-plasma flame

Specie E1 where the invention is directed to MCVD

Specie E2 where the invention is directed to OVD

Specie E3 where the invention is directed to VAD

Specie E4 where the invention is directed to an extrusion-type process, such as in instant figure 23.

Specie E5 wherein the invention is directed to planar deposition (claim 27)

Specie F1 wherein the substrate is the substrate heater

Specie F2 wherein the substrate heater is external to the substrate

Specie F3 wherein the substrate heater is internal to the substrate

Specie G1 wherein the heater and substrate have identical compositions

Specie G2 where the heater and substrate have dissimilar compositions

Specie H1 wherein the substrate is removed from the preform by melting a thin film of the preform (fig 12)

Specie H2 wherein the substrate is removed by melting the entire preform (fig 20)

Specie I1 where the substrate has a variable cross section

Specie I2 where the substrate has a constant cross section

Specie J1 where the substrate is porous

Specie J2 where the substrate is non-porous

Specie K1 Where the dopant is added via dopant particles

Specie K2 where the dopant is added via a dopant fluid

Specie L1 where the material is consolidated essentially simultaneously with deposition - thus forming a non-porous body.

Specie L2 where the material is deposited as sticky particles and thus creates a porous body which is (or maybe) subsequently sintered to form the solid body

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Specie M1 where the body is sintered/consolidated before removal of the substrate

Specie M2 where the body is sintered/consolidated after removal of the substrate

Specie N1 where the final cladding is doped

Specie N2 where the final cladding is not doped

Specie O1 where the final core is doped

Specie O2 where the final core is not doped.

Specie P1 where the substrate is made from synthetic silica

Specie P2 where the substrate is made from natural quartz

Specie P3 where the substrate is made from graphite

Specie P4 where the substrate is made from silicon carbide

Specie P5 where the substrate is made from boron nitride

Specie P6 where the substrate is made from metal.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for each grouping prosecution on the merits to which the claims shall be restricted if no

generic claim is finally held to be allowable (i.e. on specie from the A groups, one from the B groups, etc.). Currently, no claim is generic to all species.

Applicant is advised that a reply to this requirement **MUST** include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Undue burden: The above constitutes a prima facie showing that the claims present an undue burden to the Office. Further it is noted that 150 claims also constitutes an undue burden. Furthermore, it is noted that all of the present claims

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would require Examiner to search in class 65/ subclasses 384, 386, 391, 393, 395, 399, 401, 404, 412, 413-415, 419, 421-422, 425, 427-428, for just the method subs. There would be a like number of apparatus subclasses that needed to be searched. Lastly, all the above species that are indicated above results in over a million possible permutations; although not all of such permutations would be meaningful, it does demonstrate that the number of species that Applicant has presented would create an unimaginable burden on the Office.

Applicant is reminded that if a claim is found to be allowable, that all species which depend from that claim would be rejoined and allowed.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hoffmann whose telephone number is 703-308-0469. The examiner can normally be reached on Monday through Friday, 7:00- 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Griffin can be reached on 703-308-1164. The fax phone numbers for

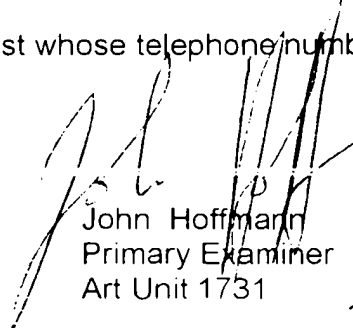
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the organization where this application or proceeding is assigned are 703-305-7115 for regular communications and 703-305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.


John Hoffmann
Primary Examiner
Art Unit 1731

5-14-03

jmh
May 14, 2003